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10/814,547	03/31/2004	Richard Warren Hailey	014586-9013-00	7402
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EXAMINER				
FABER, DAVID				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,547

Applicant(s)

HAILEY ET AL.

Examiner

DAVID FABER

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 3/18/08, 5/20/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the Request for Continued Examination filed on 20 May 2008 and the Information Disclosure Statements filed on 18 March 2008 and 20 May 2008.

This office action is made Non-Final.

2. Claims 1-7, 11, 13-23, and 27-29 have been amended.

3. The rejection of Claims 16-30 under 35 USC 112, second paragraph, has been withdrawn as necessitated by the amendment. The rejection of Claims 1, 12, and 13 under 35 U.S.C. 102(e) as being anticipated by Joshi et al (US Patent #7,299,409, filed 3/7/2003) has been withdrawn as necessitated by the amendment. The rejection of Claims 2-6, 7-11, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joshi et al in further view of Harold et al (Harold et al, "XML in a Nutshell, Second Edition", printed June 2002, pp 171, 378, 383, 398, 431, 438-439, 444-445, 448, and 451-452) has been withdrawn as necessitated by the amendment. The rejection of Claims 16-17, and 28-30 under 35 U.S.C. 103(a) as being unpatentable over Joshi et al in further view of Poole et al (US Patent #6,006,242, patented 12/21/1999) has been withdrawn as necessitated by the amendment. The rejection of Claims 18-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joshi et al in further view of Poole et al in further view of Harold et al has been withdrawn as necessitated by the amendment.

4. Claims 1-30 are pending. Claims 1, 14-16, and 28 are independent claims.

Information Disclosure Statement

5. The information disclosure statements (IDS) submitted on 18 March 2008 and 20 May 2008 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 1 and 14 recites the limitation "one or more instances of a document" in line 18, and line 20, respectively. Examiner is unsure if this element dynamic document structure is a new element or depending of the element "at least one instance of a document" introduced in line 8 of Claim 1, and line 11 of Claim 14, respectively. Thus, there is insufficient antecedent basis for this limitation in the claim.

9. Claims 1 and 14 recites the limitation "each dynamic document structure" in line 17, and line 18, respectively. Examiner is unsure if this element dynamic document structure is a new element or depending of the element "one or more computer-processable dynamic document structures" introduced in line 7 of Claim 1, and line 10 of Claim 14, respectively. Thus, there is insufficient antecedent basis for this limitation in the claim.

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10. Claims 1 and 14 recites the limitation "at least one dynamic document structure" in line 22, and line 22, respectively. Examiner is unsure if this element dynamic document structure is a new element or depending of the element "one or more computer-processable dynamic document structures" introduced in line 7 of Claim 1, and line 10 of Claim 14, respectively. Thus, there is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 12-13, 16-17, and 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Poole et al (US Patent #6,006,242, patented 12/21/1999).

As per independent claim 1, Poole et al discloses a method:

- creating a transaction data set; (Column 5, lines 3-7; Column 29, STEP 1: collecting transaction data by instantiating (or create) business objects.)
- establishing a set of computer-processable rules in accordance with a rules markup language; (Column 5, lines 3-24; Column 5, line 63-Column 6, line 14; Column 7, lines 28-60: The document developer specifics content to be put into the final document in order to meet the objectives of the parties in a

transaction and to meet certain business, legal, and/or government rules and regulations. The document is constructed in SGML)

- configuring each rule in the set of computer-processable rules is configured to be embedded in one or more computer-processable documents dynamic document structures and to determine the content to be included in at least one instance of a document generated from one of the one or more computer-processable dynamic document structures; (Column 5, lines 3-62; Column 6, lines 49-64; Column 7, lines 28-60: As disclosed above, the document developer specifics content to be put into the final document in order to meet the objectives of the parties in a transaction and to meet certain business, legal, and/or government rules and regulations. Each of the constituent portions of the document is associated with an entity reference wherein the references are check to make sure they follow all business, legal, and government requirements (rules) which produces content fragments having integrity by virtue of being complaint with one or more business, legal, or government requirements. In other words, content included in the document follow all the required rules implemented that define the content that is to be placed into the document. Furthermore, as stated in Column 5, lines 3-24, and Column 7, lines 37-40, each document component is linked to a business government regulation source, wherein each content of the regulation is incorporated into a final by referencing its corresponding

document content. (Col 7, lines 28-60) Since each of the content of the regulation is incorporated by referencing the document component into the final document, the regulations/rules are embedded into the documents which defines the content in the document.)

- creating a computer-implemented database; storing each rule in the set of computer-processable rules in the database; storing content in the database; (Column 4, lines 54-56; Column 6, lines 15-48)
- associating the stored content with one or more rules from the set of computer- processable rules in the database; (Column 5, lines 3-62; Column 6, lines 49-64; Column 7, lines 28-60)
- configuring each dynamic document structure to have a tree- architecture, to resolve to one or more instances of a document, to include document content including one or more embedded rules (Poole et al discloses a dynamic document structure in FIG 1; Col. 1 lines 15-20, whereby dynamically constructing an electronic document for subsequent publication in pre-printed or electronic form. Poole discloses the document construction resolves an instance of a document in FIG 2, Col. 5 lines 54-60 wherein instance contains unresolved entity references. When an entity reference within a reference is resolved, a new document instance is produced, thus resolving a document instance, Furthermore, Poole et al discloses that the document construction (structure) is configured to include one or more rules.... FIG 1, Column 5, lines 1-24 discloses Poole's document construction includes business, legal

and/or government rules and regulation that specifies the content used in the document. Furthermore, as stated in Column 5, lines 3-24, and Column 7, lines 37-40, each document component is linked to a business government regulation source, wherein each content of the regulation is incorporated into a final by referencing its corresponding document content. (Col 7, lines 28-60) Since each of the content of the regulation is incorporated by referencing the document component into the final document, the regulations/rules are embedded into the documents which defines the content in the document. Furthermore, Poole et al discloses in Column 4, lines 6-16, Claim 17; a SGML parser parsing a document creates a tree wherein implicitly a tree is created that contains at least one root node. After parsing and during validating, process implicitly starts at top of the tree at the root and work its way down the tree)

- resolving, with a computer processor and in accordance with the transaction data set, at least one dynamic document structure by executing the one or more embedded rules to create a specific instance of a document in a static form. (Column 5, lines 3-62; Column 6, lines 49-64; Column 7, lines 28-60. In addition, Column 18, line 56 – Column 19, line 11, discloses creation about static documents, or specific instances in document are created in static. Also discloses how static documents are different than dynamic indicating static documents remain unchanged for many transactions. Poole et al discloses the document construction methodology providing dynamic construction and

alternation of both static and dynamic documents.)

As per dependent claim 12, Poole et al discloses a method:

- creating a static document structure that can be resolved into one or more instances of a document that includes at least some content that is determined before and some content that is unchanged during and after a resolution process. (Column 18, line 56 – Column 19, line 11: Discloses creation about static documents, and how static documents are different than dynamic indicating static documents remain unchanged for many transactions)

As per dependent claim 13, Poole et al discloses a method:

- providing a data set (Column 4, lines 54-56) configured to be processable by one or more rules built on the architecture for a set of rules (Column 6, line 34: rules that dictate the access and utilization of components; Claim 16)

As per independent claim 16, Claim 16 recites similar limitations as in Claim 1, and is similarly rejected under rationale. Furthermore, Poole et al discloses a method:

- retrieving one or more cross-referenced document components from a data base, the one or more document components configured to include one or more rules the one or more embedded rules defining content to be included in documents; (FIG 1, Column 5, lines 10-24; In addition, Column 7, lines 31-40)

discloses a document may be defined from text and graphical components accessed from a Knowledge base. In addition, the Knowledge Base includes rules being stored. (Column 6, lines 15-30) Each of the constituent portions of the document is associated with an entity reference wherein the references are check to make sure they follow all business, legal, and government requirements (rules) which produces content fragments having integrity by virtue of being complaint with one or more business, legal, or government requirements. In other words, content included in the document follow all the required rules implemented that define the content that is to be placed into the document. Furthermore, as stated in Column 5, lines 3-24, and Column 7, lines 37-40, each document component is linked to a business government regulation source, wherein each content of the regulation is incorporated into a final by referencing its corresponding document content. (Col 7, lines 28-60) Since each of the content of the regulation is incorporated by referencing the document component into the final document, the regulations/rules are embedded into the documents which defines the content in the document.)

- processing the one or more cross-referenced document components in a processor to generate a tree having a root node; processing the tree beginning at the root node; (Column 4, lines 6-16: parsing a document creates a tree wherein inherently a tree is created that contains at least one root node. After parsing and during validating, process inherently starts at top of the tree at the root and work its way down the tree.)

- when a rule is encountered, evaluating the rule and replacing it with a value;
(Column 45, lines 18-27: rules are evaluated, and replaces rules with objects
presenting a value)

As per dependent Claim 17, Poole et al discloses a method:

- establishing an architecture for a set of rules (Column 5, lines 1-10; FIG 1)

As per independent claim 28, Claim 28 recites similar limitations as in Claim 16 and is similarly rejected under Poole et al.

As per dependent claim 29, Claim 29 recites similar limitations as in Claim 17 and is similarly rejected under Poole et al.

As per dependent Claim 30, Claim 30 recites similar limitations as in Claim 28 and is rejected under rationale. Furthermore, Poole et al discloses establishing a list of data structures. (Column 4, lines 53-56: a collection of documents is a list of data structures)

13. Claims 2-6, 7-11, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Poole et al (US Patent #6,006,242, patented 12/21/1999) in further view of Harold et al (Harold et al, "XML in a Nutshell, Second Edition", printed June 2002, pp 171, 378, 383, 398, 431, 438-439, 444-445, 448, and 451-452).

As per dependent claims 2-6, Poole et al fails to specifically disclose creating a schema having a condition element, a choose element, an iterators element, and a functions element. However, Harold et al discloses a condition element (xs:Boolean, Page 398; xs:if, Page 439), choice element (xs:choice, Page 378), iterators element

(xsl:for-each, iterates over the nodes that are identified, Page 438), and a functions element (xs:import, its function is to import, Page 383).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Poole et al's method with Harold et al's disclosure since it would have provided the user the benefit of supplying the user with information on assigning types to elements and attributes and allowing the user to define custom types.

As per dependent claim 7-11, Poole et al fails to specifically disclose creating a schema having an external interface element that is configured to be resolved into a value, wherein the value is chosen from a group that includes a set, an XML DOM node, and an XML DOM node list, and wherein the external data interface element is configured to have an entity reference attribute and a return type attribute, and having an internal interface and an external interface element.. However, Harold et al discloses an param element (xsl: param, (receives a value) Page 444; xsl:with-param, (sends a value) p451) that sends/receives a named parameter (value) that contain attributes of a name and a select expression. (Page 445, 452) The name represents the parameter's name or entity reference and the select expression that represented to return a value of a particular type. (Page 431) In addition, the retrieved value can be a node-set (p431, 171), a collection of Xpath nodes. (p171) In addition, the xsl:template provides information how data is used including the received value using xsl:param. (p444-445, 448)

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Poole et al's method with Harold et al's disclosure since it would have provided the user the benefit of supplying the user with information on assigning types to elements and attributes and allowing the user the ability to retrieve the information from an outside source.

As per independent Claim 14, Claim 14 recites similar limitations as in Claim 1 and is similarly rejected under rationale.

Poole et al fails to specifically disclose creating a schema having a condition element, a choose element, an iterators element, and a functions element, and having an external interface element that is configured to be resolved into a value. However, Harold et al discloses a condition element (xs:Boolean, Page 398; xsl:if, Page 439), choice element (xs:choice, Page 378), iterators element (xsl:for-each, iterates over the nodes that are identified, Page 438), and a functions element (xs:import, its function is to import, Page 383). In addition, Harold et al discloses an param element (xsl: param, Page 444; xsl:with-param, p451) that receives a named parameter (value) that contain attributes of a name and a select expression. (Page 445, 452) The name represents the parameter's name or entity reference and the select expression that represented to return a value of a particular type. (Page 431) In addition, the retrieved value can be a node-set (p431, 171), a collection of Xpath nodes. (p171)

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Poole et al's method with Harold et al's disclosure since it would have provided the user the benefit of supplying the user with

information on assigning types to elements and attributes, allowing the user to define custom types and retrieve the information from an outside source.

As per independent Claim 15, Claim 15 recites similar limitations in as in Claim 1, 12 and Claim 14 combined, and is similarly rejected under Poole et al and Harold et al.

As per dependent claims 18-22, Claims 18-22 recite similar limitations as in Claims 2-6, and are similarly rejected under rationale.

As per dependent claims 23-27, Claims 23-27 recite similar limitations as in Claims 7-11, and are similarly rejected under rationale.

Response to Arguments

14. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

15. Arguments addressing in regards of the new limitations of Claims 1, 12-13, 16-17, and 28-30 brought forth in the amendments: creating a transaction data set; establishing a set of computer-processable rules in accordance with a rules markup language; configuring each rule in the set of computer-processable rules is configured to be embedded in one or more computer-processable documents dynamic document structures and to determine the content to be included in at least one instance of a document generated from one of the one or more computer-processable dynamic document structures; creating a computer-implemented database; storing each rule in the set of computer-processable rules in the database; storing content in the database; associating the stored content with one or more rules from the set of computer-

processable rules in the database; configuring each dynamic document structure to have a tree- architecture, to resolve to one or more instances of a document, to include document content including one or more embedded rules; resolving, with a computer processor and in accordance with the transaction data set, at least one dynamic document structure by executing the one or more embedded rules to create a specific instance of a document in a static form, has been viewed the new ground of rejection of 35 USC 102(b) under new references using Poole et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/David Faber/

Examiner, Art Unit 2178

/CESAR B PAULA/

Primary Examiner, Art Unit 2178